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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/681,749	10/07/2003	Philipp Lang	2960/112	8140
75059                      7590                      11/13/2008 BROMBERG & SUNSTEIN LLP 125 SUMMER STREET BOSTON, MA 02110-1618				
EXAMINER				
PHILOGENE, PEDRO				
ART UNIT		PAPER NUMBER		
3733				
MAIL DATE		DELIVERY MODE		
11/13/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/681,749

**Applicant(s)**

LANG ET AL.

**Examiner**

Pedro Philogene

**Art Unit**

3733

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-36, 38-69, 76-78, 80, 84, 93-96 and 123-125 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-36, 38-78, 80, 84, 93-96 and 123-125 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/18/08
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-, 38-69, 76-78, 80, 84, 93-96, 123-125 are rejected under 35 U.S.C.

112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Applicant fails to disclose in the specification and drawings "at least a portion of **each** of the first and second surfaces of the implant has a three dimensional shape that substantially conforms with or duplicates the shape of the first articular surfaces".

***Drawings***

The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the "portion of each of the first and second surfaces of the implant has a three-dimensional shape that substantially conforms with or duplicates the shape of the first articular surface" must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure

number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-36, 38-69, 76-78, 80, 84, 93-96 are rejected under 35 U.S.C. 103(a) as being unpatentable over Felt et al. (6,652,587) in view of Hollister (5,522,900).

With respect to claims 1, 34, 80, 84, , 93, as understood, Felt et al. disclose an articular implant having a first surface and a second surface wherein the first surface opposes a first articular surface joint and the second surface opposes a second articular surface of the joint, as best seen in the FIGS; and further wherein a portion of at least a portion of each of the first and second surfaces has a three-dimensional shape that

either substantially conforms with or duplicate the shape of the first articular surface, such that the movement of the implant in the joint is limited without an attachment mechanism; as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67. As to a first component of the plurality of components engages a second component of a plurality of components in at least one of slidably and rotatably, see column 13, lines 10-67, column 14, lines 1-67, column 15, lines 1-58, and as best seen in the FIGS.

With respect to claims 2-33, 35-36, 38-69, 94-96, Felt et al discloses all the limitations, as set forth in column 4, lines 20-67, column 5, lines 1-67, column 6, lines 1-67, column 7, lines 1-67, column 8, lines 1-67, column 12, lines 40-67, column 13, lines 1-10, column 14, lines 50-60, column 17, lines 50-67, column 18, lines 1-67, column 19, lines 1-67, column 20, lines 1-67 column 21, lines 1-67, column 22, lines 1-67 column 23, lines 1-67.

With respect to claims 76-78, the method steps, as set forth, would have been obviously carried out in the operation of the device, as set forth above.

It is noted that Felt et al did not teach of a surface having at least one of a convexity and a concavity on the first and second surfaces of the implant or a plurality of convexities and a plurality of concavities on the first and second surfaces of the implant; as claimed by applicant. However, in similar art, Hollister provides the evidence of an

implant having a surface having at least one of a convexity and a concavity on the first and second surfaces of the implant or a plurality of convexities and a plurality of concavities on the first and second surfaces of the implant to correctly mimic the anatomical structure of the joint being replaced.

Therefore, given the teaching of Hollister, it would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the device of Felt et al., as taught by Hollister to provide a surface in the implant to correctly mimic the anatomical structure of the joint being replaced.

#### ***Response to Amendment***

Applicant's arguments filed 7/16/08 have been fully considered but they are not persuasive. Applicant stated that Felt did not teach of "at least a portion of each of the first and second surfaces of the implant has a three dimensional shape that substantially conforms with or duplicates the shape of the first articular surface". However, in a conversation with applicant on 11/7/08, applicant agrees with the examiner that applicant did not teach of "at least a portion of each of the first and second surfaces of the implant has a three dimensional shape that substantially conforms with or duplicates the shape of the first articular surface". Applicant was asked by the examiner to at least show in the drawings where each of the first and second surfaces conforms or duplicates the shape of the first articular surface, however applicant was unable to do that. Therefore, as understood, the examiner believes that the reference to Felt et al. meets the claims. This action is made final.

#### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Pedro Philogene whose telephone number is (571) 272-4716. The examiner can normally be reached on Monday to Friday 6:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eduardo Robert can be reached on (571) 272 - 4719. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Pedro Philogene/  
Primary Examiner, Art Unit 3733  
November 7, 2008